

REMARKS

Claims 1-23, 26-31 and 35-37 are pending. In the Office Action dated March 26, 2007 (the "Office Action"), the Examiner took the following action: (1) rejected claims 1-23, 26-31 and 35-37 under 35 U.S.C. § 251 as being an improper recapture of broadened claimed subject matter; (2) objected to the reissue declaration as being defective because the error which is relied upon to support the reissue application is not an error upon which a reissue can be based; and (3) rejected claims 1-23, 26-31 and 35-37 as being based upon a defective reissue declaration under 35 U.S.C. § 251.

Claims 23 and 35 have been amended to correct the error that Applicant has claimed less than he had a right to claim in the parent application (Application No. 08/857,100, now U.S. Patent No. 5,984,190). Claims 28-31 have been cancelled. New claims 38-42 have been added to support the amendment to claims 23 and 35. No new matter has been added.

As previously mentioned, claims 1-23, 26-31 and 35-37 have been rejected under 35 U.S.C. § 251 as being an improper recapture of broadened claimed subject matter. In particular, the Examiner stated that in the parent case "the limitation of claim 3, 'accessing a look-up table' was added into each independent claim to make the claims allowable." (Office Action, page 2)

However, if the reissue claim recites a broader form of the key limitation added/argued during original prosecution to overcome an art rejection (and therefore not entirely removing that key limitation), then the reissue claim may not be rejected under the recapture doctrine. See *M.P.E.P.* § 1412.02C; *M.P.E.P.* § 1412.02C(2)(d); *Ex Parte Eggert*, 67 USPQ2d 1716. For example, if the key limitation added to overcome an art rejection was "an orange peel," and the reissue claim instead recites "a citrus fruit peel," the reissue claim may not be rejected on recapture grounds. *M.P.E.P.* § 1412.02C.

In the original prosecution, the limitation "accessing a lookup table" was added to independent claims 1, 6, and 19, and the limitation "accessed through a lookup table" was added to independent claims 10 and 14. Yet, as disclosed in the specification of the parent application, a lookup table is merely one embodiment of a "correlation mechanism" for correlating optical identification marks 14-14B with the particular electronic identification data stored in the

identification circuit 12 (page 5, lines 20-23). Consequently, Applicant respectfully submits that, by adding the limitation “a lookup table” rather than a broader form thereof in the original prosecution, Applicant has claimed less than he had a right to claim.

The present reissue application is intended to correct such error by amending reissue claims 23 and 35 to recite a broader form of the limitations “accessing a lookup table” and “accessed through a lookup table” that were added during the original prosecution. Specifically, reissue claim 23 has been amended to recite associating the optical identification code with the read electronic identification information *through a correlation mechanism*. Similarly, reissue claim 35 has been amended to recite cross-referencing the optical identification code with the read electronic identification information *by utilizing a correlation instrument*. The amendment to each of reissue claims 23 and 35 is supported in the specification of the parent application (page 5, lines 20-23).

Even assuming the limitation “accessing a lookup table” or “accessed through a lookup table” was added into the independent claims in the original prosecution for the purpose of making the claims allowable, the present amendment to each of reissue claims 23 and 35 is a broader form of “a lookup table” and, thus, may not be rejected under the recapture doctrine. *M.P.E.P. § 1412.02C*. In other words, in the original prosecution Applicant made an error by claiming less than he had a right to claim, and such error is what Applicant intends to correct through the present reissue application by reciting a broader form of the limitations “accessing a lookup table” and “accessed through a lookup table.”

Therefore, in view of the present amendment to the reissue claims and *M.P.E.P. § 1412.02C*, Applicant respectfully submits that rejection under the recapture doctrine is now moot. Consequently, for the foregoing reasons, the rejection of claims 1-23, 26-31 and 35-37 under 35 U.S.C. § 251 should be withdrawn.

With regards to the objection to the reissue declaration as being defective because the error which is relied upon to support the reissue application is not an error upon which a reissue can be based, Applicant respectfully submits that the objection is moot as previously discussed. Therefore, the objection to the reissue declaration as being defective should be withdrawn.

Regarding the rejection of claims 1-23, 26-31 and 35-37 as being based upon a defective reissue declaration under 35 U.S.C. § 251, Applicant respectfully submits that the rejection is moot for the foregoing reasons and, therefore, should be withdrawn.

All of the claims remaining in the application are clearly allowable. Applicant believes the error that less was claimed than Applicant had a right to claim in the parent application is corrected by the amendment to the claims. Favorable consideration and a timely Notice of Allowance are earnestly solicited.

Respectfully submitted,
DORSEY & WHITNEY LLP



Paul T. Meiklejohn
Registration No. 26,569
Telephone No. (206) 903-8800

PTM (EWB):dms

Enclosures:

Postcard

Fee Transmittal Sheet (+copy)

DORSEY & WHITNEY LLP
1420 Fifth Avenue, Suite 3400
Seattle, WA 98101-4010
(206) 903-8800 (telephone)
(206) 903-8820 (fax)

h:\ip\clients\micron technology\00\500060.02\500060.02 amend oa 032607.doc